

Appl. No. 10/087,697  
Reply to Office Action of July 28, 2004

Remarks

Introduction

Claims 1-27 were pending. By way of this response, claims 2-4, 6-16, 18, 19, and 20-25 have been amended, claims 1, 5, 17, and 26-27 have been cancelled without prejudice, and claims 28-33 have been added. Support for the new claims and the amendments to the claims can be found in the application as originally filed, and no new matter has been added. Accordingly, claims 2-4, 6-16, 18-25, and 28-33 are currently pending.

Claim 28 has been added to replace claim 1, and claim 31 has been added to replace claim 17.

Rejections Under 35 U.S.C. § 103

Claims 1-27 have been rejected under 35 U.S.C. § as allegedly being unpatentable over Kennedy et al. (U.S. Patent No. 6,523,954; hereinafter Kennedy) in view of Hosoi et al. (U.S. Patent No. 5,956,121; hereinafter Hosoi).

Applicant has amended and added the claims as set forth above, and applicant traverses the rejection as it relates to the present claims 2-4, 6-16, 18-25, and 28-32.

Kennedy discloses a system and method for screening an eye. The system includes an ocular disease and abnormality detection device 10 that obtains images of a patient's eye (col. 4, lines 9-12, and FIG. 1). The system also includes a central analysis facility 200 remotely located from the detection device 10 (col. 6, line 51 to col. 7, line 6; and FIG. 7). The system also

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includes one or more remotely located reading centers or readers 208, 210, 212 (col. 7, lines 40-43; and FIG. 7). Readers are individuals that are trained to view images of patient's eyes and evaluate those images for signs of disease, abnormalities, or impaired vision (col. 9, lines 56-60).

The method disclosed by Kennedy includes steps of obtaining image data of one or more patient's eyes and transmitting that image data to the central analysis facility 200 (see FIG. 8a). After the data are stored at the central analysis facility 200, remotely located readers or reading centers are selected based on a number of criteria, including reader availability (col. 9, lines 29-66). When the appropriate remote reader or reading center is selected, the image data is transmitted from the central analysis facility 200 to the remote reader or reading center, where the image data can be analyzed. After the analysis, the reader transmits an analysis of the patient's eye exam back to the central analysis facility 200. Information can be provided so that a report can be generated for the patient.

In short, Kennedy discloses a system that includes one or more readers remotely located from the central analysis facility 200, and a method that requires eye examination data to be transmitted from the central analysis facility 200 to the reader located at the remote location.

Hosoi discloses a telecommunication system for examining an eye. In particular, the system disclosed by Hosoi includes a plurality of identical eye exam units (such as Optician Shops; see FIG. 1) in communication with each other such that an examiner may conduct an eye exam at one eye exam site of a patient located at a different eye exam site. Thus, the

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examiner can operate an ophthalmic apparatus and perform an ophthalmic examination without being present with the patient (col. 1, lines 40-42).

Applicant submits that a *prima facie* case of obviousness has not been established because the Examiner has failed to indicate where in the prior art a motivation or suggestion is provided to combine the teachings of Kennedy and Hosoi, and because, even if the references could be erroneously combined, the combination of references fails to disclose, teach, or even suggest all of the limitations recited in the present claims.

Applicant submits that Kennedy and Hosoi, taken alone or in any combination, do not disclose, teach, or suggest the present invention. For example, Kennedy does not disclose, teach, or even suggest a system comprising a diagnostic center that comprises an exam console for displaying transmitted information, such as graphics and/or text, corresponding to the collected information to an eye care practitioner located at the diagnostic center for analysis of the information, as recited in the present claims. Similarly, Hosoi does not disclose, teach, or even suggest a system comprising a diagnostic center, let alone, a diagnostic center that comprises an eye console for displaying transmitted information, such as graphics and/or text, corresponding to the collected information to an eye care practitioner located at the diagnostic center for analysis of the information, as recited in the present claims.

As discussed above, Kennedy specifically discloses that the central analysis facility, which includes a database, transmits the ophthalmic or eye exam information to a reader that is remotely located from the central analysis facility. In other

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words, Kennedy discloses that the central analysis facility does not comprise an exam console that displays graphics and/or text-based information to an eye care practitioner located at the central analysis facility. Applicant submits that Kennedy actually teaches away from the presently claimed systems and methods since Kennedy specifically teaches that the reader, or eye care practitioner, is at a location remote from the central analysis facility. Indeed, Kennedy discloses the importance of having readers remotely located from the central analysis facility to permit the Kennedy system to select certain readers based on a number of selection criteria. "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994)).

Kennedy is in direct contrast to the present invention in which the eye care practitioner is located at the diagnostic center, as recited in the present claims.

Hosoi does not disclose any diagnostic center whatsoever, let alone, a diagnostic center which comprises an exam console, as recited in the present claims.

Applicant submits that a person of ordinary skill in the art would not be motivated to combine the teachings of Kennedy and the teachings of Hosoi because their respective systems are substantially different and distinct, one from the other. As discussed above, the system disclosed by Kennedy requires transmission of eye exam data from a central analysis facility to remotely located readers to provide a diagnosis of the eye exam. In contrast, Hosoi discloses a system that permits an examiner at one eye examination site to control an ophthalmic

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apparatus at another identical eye examination site, which is remote from the first examination site. The system of Hosoi does not even suggest any diagnostic center, let alone a diagnostic center which transmits data to remote readers, as disclosed by Kennedy. Thus, applicant submits that a person of ordinary skill in the art would not be motivated to combine Kennedy and Hosoi, let alone to do so, and obtain the claimed invention. Only after knowing of applicant's invention and disclosure would one of ordinary skill in the art even consider modifying and extending the deficient teachings of Kennedy and Hosoi. Such hindsight reconstruction of the prior art based on applicant's own invention and disclosure is an improper basis for rejecting patent claims.

Moreover, even if the teachings of Kennedy and Hosoi could be erroneously combined, the combination fails to disclose, teach, or even suggest all of the limitations of the present claims. For example, as discussed above, the combination of Kennedy and Hosoi fails to disclose, teach, or even suggest a system that comprises a diagnostic center which comprises an exam console for displaying transmitted information corresponding to the collected information to an eye care practitioner located at the diagnostic center for analysis of the information, as recited in the present claims. In addition, the combination of Kennedy and Hosoi does not disclose, teach, or even suggest such a system, which further comprises a communications link for enabling substantially real-time interactive communication between an eye care practitioner located at the diagnostic center and a patient located at the at least one remote exam module and transmission of information between the diagnostic center and the at least one remote exam module, as recited in claims 28 and 32. Thus, applicant submits

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that the combination of Kennedy and Hosoi does not disclose, teach, or even suggest all of the limitations of the present claims.

Applicant submits that the presently claimed invention provides at least one advantage over the system and method disclosed by Kennedy and Hosoi. For example, the presently claimed system and method do not require an additional component or step of transmitting eye examination information to a remotely located reader. Thus, the presently claimed systems and methods are capable of providing prompt, if not immediate, diagnoses of patients undergoing eye examinations, which is not obtainable with the system and method disclosed by Kennedy and Hosoi, either alone or in any combination.

In addition, each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present system and method including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

In view of the above, applicant submits that the present claims, that is claims 2-4, 6-16, 18-25, and 28-32, are unobvious from and patentable over Kennedy in view of Hosoi under 35 U.S.C. § 103.

#### Request for Interview

In addition, to the extent the Examiner maintains the rejections of the claims, applicant respectfully requests an

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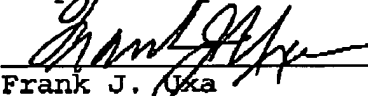
interview with the Examiner to discuss any such rejections before mailing another Office Action.

Conclusion

In conclusion, applicant has shown that the present claims are unobvious from and patentable over the prior art under 35 U.S.C. § 103. Therefore, applicant submits that the present claims, that is claims 2-4, 6-16, 18-25, and 28-33, are allowable. Therefore, applicant respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: Nov. 22, 2004

Respectfully submitted,



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